

## **REMARKS/ARGUMENTS**

In the Office Action, the IDS filed on February 12, 2004, and the claims, are objected to. Claims 1-52 are pending in the application. Claims 2, 6, 7, 32, 33 and 36-49 are withdrawn pursuant to a restriction requirement, and claims 1, 3-5, 8-31, 34, 35 and 50-52 are rejected.

### **I. Information Disclosure Statement**

The Examiner states that the IDS filed on February 12, 2004 fails to comply with 37 C.F.R. 1.98(a)(1). In response, Applicant provides a new IDS citing the same prior art, that complies with 37 C.F.R. 1.98(a)(1).

Accordingly, Applicant respectfully requests withdrawal of the objection to the IDS.

### **II. Claim Objections**

The Examiner objects to claims 18 and 20 under 37 C.F.R. 1.75 as being substantial duplicates of claim 16. In response, Applicant has cancelled claims 18 and 20.

Accordingly, Applicant respectfully requests withdrawal of the objection to the claims.

### **III. Claim Rejections Under 35 U.S.C. § 102/103**

Claims 1, 3-5, 8-12, 16-23, 25-31, 34, 35 and 52 are rejected under 35 U.S.C. §102(b) as being allegedly anticipated by U.S. Patent No. 6,105,329 to Bondoc et al. (hereafter "Bondoc").

Claim 13 is rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Bondoc in view of U.S. Patent No. 6,421,976 to Elliot et al. (hereafter "Elliot") and U.S. Patent No. 6,305,138 to Stahl et al. (hereafter "Stahl"). Claim 14 is rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Bondoc in view of Stahl. Claim 15 is rejected under 35 U.S.C.

§103(a) as being allegedly unpatentable over Bondoc in view of Elliot. Claim 24, 50 and 51 are rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Bondoc.

The Examiner alleges that Bondoc, individually or in combination, discloses or makes obvious at least each of the elements of independent claims 1, 8, 29, 34, 35, 50 and 52. Applicants respectfully disagree for the reasons pointed out below.

In order to distinguish the features of the invention, Applicants have amended independent claims 1, 8 and 50 to clarify that the outer edge corner of the shingle corresponds to the alignment notch of the anterior layer. This feature is clearly taught in the specification in paragraph [0042] and in Figs. 1-14 and 22. Accordingly, Applicants respectfully submit that no new matter has been added by way of the amendment to independent claims 1, 8 and 50, and request entry of the amendment to the claims.

As seen in Figs. 5-8, the anterior headlap 13 includes at least one alignment notch 17 positioned along the lower edge of the anterior headlap 13. The alignment notch 17 can be formed using a shape that corresponds with the posterior tab corner 20 of the posterior tabs 18. Independent claims 1, 8 and 50 clearly recite that the shingle (formed of an anterior layer having an alignment notch and a posterior layer) has an outer edge corner (20) that corresponds with the alignment notch (17).

Bondoc, on the other hand, shows an anterior layer and a posterior layer, that when joined together to form a shingle (Fig. 3), having flat right angle edges on the corners. These corners do not correspond with the alignment notch. Accordingly, Bondoc does not show this feature of claims 1, 8 and 50. The cited references of Stahl and Elliot further do not show this feature.

Further, independent claim 29 claims a roofing shingle that comprises at least one layer formed from a cutting cylinder *having a circumference that is a fraction of the roofing shingle*

*length*. Independent claims 34, 35 and 52 claim a two-layer composite roofing shingle having an anterior layer formed from a cutting cylinder *having a circumference that is a fraction of the two-layer composite roofing shingle length*. This feature is not taught by the cited references.

As set out in the specification in paragraphs [0050] – [0051], the anterior layer 11 pattern is cut using a fractional cutting cylinder, where the fractional cutting cylinder produces a pattern that is a fraction of the shingle length. This provides a *substantially* repeating pattern. For example, if a fractional cutting cylinder circumference is 75% the length of a single shingle and that cutting cylinder includes a pattern, that pattern will be repeated every fourth shingle produced after the fifth rotation of the cutting cylinder. By utilizing a fractional cutting cylinder circumference, the maximum amount of patterns for the minimum amount of diameter can be produced.

The Examiner, on page 6 of the Office Action, states that the phrase “formed from a cutting cylinder having a circumference that is a fraction of the roofing shingle length” are statements of the process of making the claimed invention. The Examiner further requires that the process must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. This process clearly distinguished the claimed invention from the prior art.

When a fractional cutting cylinder is used for cutting an anterior layer, each anterior layer of the roofing shingle will be different for a certain number of shingles. For example, when a fractional cutting cylinder circumference is 75% the length of a single shingle and that cutting cylinder includes a pattern, then the pattern will be reproduced after every four shingles. For example, if such a fractional cutting cylinder was used to cut the anterior layer for the shingles in Figs. 5-8, after the anterior layer for the shingle in Fig. 5, the anterior layer in Fig. 8 would be

produced, then the anterior layer in Fig. 7 would be produced, and then the anterior layer in Fig. 6 would be produced. After the anterior layer in Fig. 6, it would repeat, and the shingle in Fig. 5 would again be produced. Thus the pattern would repeat after four shingles were made, but after four *different anterior layers were fabricated* by the fractional cutting cylinder. By changing the fraction from 75% to another fraction, the maximum amount of patterns for the minimum amount of diameter can be produced.

In Bondoc, however, the same shingle is produced. Bondoc does not teach a fractional cutting cylinder. In Bondoc, the cutting cylinder would be the same as the shingle length to produce the same shingle over and over, as is known in the prior art. Claims 29, 34, 35 and 52 claim a roofing shingle having a layer formed from a cutting cylinder having a circumference that is a fraction of the roofing shingle length. This allows for a structural difference between the claimed invention and the prior art, as required by the Examiner. Accordingly, Applicants submit that Bondoc does not show this feature of claims 29, 34, 35 and 52, and that the cited references of Stahl and Elliot further do not show this feature.

Anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim. Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458, 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984). Accordingly, as Bondoc fails to teach the features of the independent claims as discussed above, it is respectfully submitted that the 35 U.S.C. § 102(b) rejection of the claims is improper.

With regard to the remaining dependent claims, since the dependent claims incorporate all the limitations of the independent claims and recite additional unique elements and/or

limitations, these claims remain patentable because the cited reference does not supply the elements with respect to the independent claims.

Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 102(b) rejection of claims 1, 3-5, 8-12, 16-23, 25-31, 34, 35 and 52 as being allegedly anticipated by Bondoc.

Regarding the §103(a) rejection of claims 13-15, 24, 50 and 51, it has been held by the Courts that to establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). For the reasons distinguishing the claims from Bondoc and/or Stahl and Elliot above, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection of the claims is also improper. Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection of claims 13-15, 24, 50 and 51.

#### **IV. Conclusion**


In view of the aforementioned remarks and amendments, the Applicants believe that each of the pending claims is in condition for allowance. Accordingly, Applicants respectfully request allowance of claims 1, 3, 8-17, 19, 21-31, 34-35 and 50-52.

If, upon receipt and review of this amendment, the Examiner believes that the present application is not in condition for allowance and that changes can be suggested which would place the claims in allowable form, the Examiner is respectfully requested to contact Applicants' undersigned counsel at the number provided below.

Please charge any additional fees that may be due, or credit any overpayment of same, to  
Deposit Account No. 03-1250 (Ref. No. FDN-2797).

Respectfully submitted,

Date: 12/29/06

  
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